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To: Commissioner for Patents for Examiner Kim T. Huynh Group Art Unit 2112	Facsimile No.: 571/273-8300
From: Jennifer Pilcher Legal Assistant to Wayne Bailey	No. of Pages Including Cover Sheet: 6
Message: Transmitted herewith: <ul style="list-style-type: none">• Transmittal Document; and• Reply Brief.	
Re: Application No. 09/731,998 Attorney Docket No: AUS9-2000-0546-US1	
Date: Thursday, September 08, 2005	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 08 2005

In re application of: Benkema et al.

Serial No.: 09/731,998

Filed: December 7, 2000

For: Transferring Foreign Protocols
Across a System Area Network

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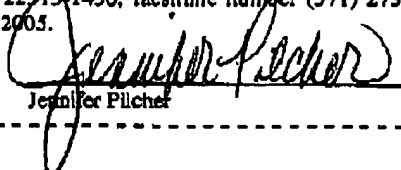
Group Art Unit: 2112

Examiner: Huynh, Kim T.

Attorney Docket No.: AUS9-2000-0546-US1

35525

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By: 
Jennifer Plichter

TRANSMITTAL DOCUMENT

Commissioner for Patents
P.O. Box 1450
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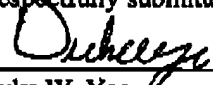
Sir:

ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,


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SEP 08 2005

Docket No. AUS9-2000-0546-US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Beukema et al.

Serial No. 09/731,998

Filed: December 7, 2000

For: Transferring Foreign Protocols
Across a System Area Network

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Group Art Unit: 2112

Examiner: Huynh, Kim T.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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By:

Jennifer Pilcher

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on July 13, 2005.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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ARGUMENT

In an appeal brief filed April 26, 2005, Appellants argued that the Examiner had failed to properly meet their burden of proof in establishing that a provisional patent application being relied upon in the rejection of all claims was enabling, and that without establishing such enablement, the Examiner could not rely upon the filing date of the provisional application to be the effective US filing date of the actual reference (US2002/0026517 A1) that the Examiner was using in the rejection of all claims. The provisional application was never mentioned by the Examiner in finally rejecting the claims, the provisional application was never listed on a form PTO -892, and a copy of the provisional application was never provided to Appellants during the prosecution of the present application.

In response to this argument, the Examiner states that "Appellants may access the provisional application on the public pair, and that the Examiner is not required to provide a copy since it is readily accessible". Appellants urge that while such provisional applications may be accessible *today*, at the time the Examiner finally rejected all claims (July 29, 2004), and at the time Appellants were required to make a decision as to whether to timely appeal such rejection without late fees (no later than October 29, 2004), Appellants were unable to access the public pair system to gain access to such provisional application, as the availability of the public pair system to access such provisional applications was announced in the Official Gazette on November 23, 2004 (see attached Evidence Appendix) – i.e. *after* the present appeal was initiated. Thus, at the time the Examiner finally rejected all claims, the Examiner had not met their burden of being able to rely upon the date of filing the provisional application as being the effective US filing date for US2002/0026517 A1, and since the burden was not met the Examiner could only rely on the actual US filing date for US2002/0026517 A1, which is June 29, 2001 (and which does not predate the US filing date of the present application under appeal).

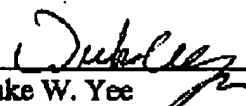
A fundamental premise of the patent prosecution process is the Examiner establishing a *clear basis* for the final rejection of claims, per 37 CFR 1.113(b). The Examiner has failed in this regard, by an attempt to substitute one document for another – after finally rejecting all claims - in support of the final rejection of all claims. Quite simply, if the Examiner was relying upon the teachings of the provisional application in the current final rejection (either directly, or

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indirectly by relying on the filing date of the provisional application), the Examiner should have made that clear in the record and based the rejection upon the teachings of such provisional application; or otherwise established or alleged enablement of the provisional application in order to comply with MPEP 706.02(V), and provided a copy of such provisional application to Appellants to assess the Examiner's position. This transitional practice of supplying copies of provisional applications relied upon to give prior art effect under 35 U.S.C. 102(e) to a reference applied in a rejection, established by the USPTO in December 2003 (see attached Evidence Appendix), was specifically implemented to address this type of situation and was not followed or complied with by the Examiner.

It is thus urged that the Examiner failed to timely comply with the requirements of MPEP 706.02(V), MPEP 2136.03 and 37 CFR 1.113(b), and thus the present claims have been erroneously finally rejected.

Respectfully submitted,


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EVIDENCE APPENDIX

United States Patent and Trademark Office OG Notices: 23 November 2004

Most Publicly Available Provisional Applications Can Now be Viewed Over the Internet

As a result of a recent enhancement to Public PAIR (Patent Application Information Retrieval), most provisional applications that are relied upon for their earlier filing dates in U.S. patent application publications or U.S. patents are now available to the public over the Internet. Exceptions mainly include provisional applications with filing dates prior to 1997. Any applicant wishing to view and/or print a copy of a provisional application relied upon by an examiner to give prior art effect under 35 U.S.C. 102(e) to a reference applied in a rejection, may do so using the Public PAIR website at <http://portal.uspto.gov/external/portal/pair>. If, for some reason, the desired provisional application cannot be viewed or printed from the Public PAIR website, the Public PAIR website can still be used to order a copy of the provisional application. Whether the order for the provisional application copy is placed with the Office of Public Records directly from the Public PAIR website, or by mail (using Mail Stop Document Services), the order requires the fee under 37 CFR 1.19(b) (1).

Due to the recent enhancement to Public PAIR, the Office has ended the transitional practice of supplying with Office actions a copy of any provisional application relied upon to give prior art effect under 35 U.S.C. 102(e) to a reference applied in a rejection. The purpose of the transitional practice, which began in December of 2003, was to make it easier for applicants to see the contents of such provisional applications. Now that such provisional applications can be viewed and/or printed using the Public PAIR website, the transitional practice is no longer needed.

Questions concerning the operation of the PAIR system should be directed to the Patent Electronic Business Center at (866) 217-9197.

October 29, 2004.

STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy

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